COVER SHEET FAX

KUBOVCIK & KUBOVCIK

The Farragut Building
Suite 710
900 17th Street, N.W.
Washington, D.C. 20006

TEL: 202-887-9023
FAX: 202-887-9093

To: Mail Stop Amendment
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Fax #: 571-273-8300
From: Ronald J. Kubovcik (Registration No. 25,401)
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Re :

Appl. No.	:	10/558,275	Confirmation No. 1653
Applicant	:	Keijiro TAKANISHI et al.	
Filed	:	November 23, 2005	
TC/A.U.	:	1711	
Examiner	:	Duc Truong	
Dkt. No.	:	IPE-063	
Cust. No.	:	20374	

Document transmitted herewith: (1) RESPONSE TO AND REQUEST FOR REMOVAL OF ELECTION OF SPECIES (LACK OF UNITY OF INVENTION) REQUIREMENT

(Due: December 27, 2006)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Ronald J. Kubovcik

RESPONSE TO AND REQUEST FOR REMOVAL OF ELECTION OF SPECIES (LACK OF UNITY OF INVENTION) REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

December 27, 2006

Sir:

This paper is submitted in response to the Office Action dated November 27, 2006.

The Action requires election of one of the following species:

(1) a residue from phosphonic acid,

(2) a residue from thiophosphonic acid,

(3) a residue from selenophosphonic acid,

(4) a residue from phosphonous acid,

(5) a residue from phosphoric acid,

(6) a phosphorous containing residue of the claimed formula (2), and

(7) a phosphorous containing residue of the claimed formula (3).

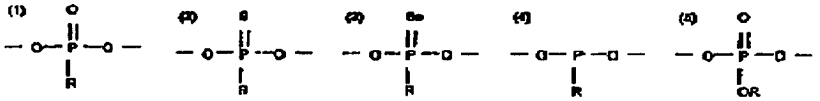
Applicants elect Group (1) as the species. Claims 1 and 8 to 12 are believed to read on the elected species. This election is made with traverse on the basis that the Office has not properly shown a lack of unity of invention in the present application.

The present application is the U.S. national stage of an international application. As noted in the action, unity of invention practice must be applied by the Office to the present application. The Office is taking the position that unity of invention is lacking under PCT Rule 13.1 because, under PCT Rule 13.2, the groups lack the same or corresponding technical feature because each species has a different chemical structure and requires a different search.

Applicants respectfully submit that the Office has not properly applied unity of invention practice. Species (1) to (5) are recited in claim 1 as a Markush group. According to Annex B of the Administrative Instructions under the PCT, in the case of

Markush groupings, unity of invention exists when the alternatives are of a similar nature. In the case of chemical compounds, a similar nature is present when all alternatives have a common property and a common structure is present, i.e., a significant structural element is shared by all of the alternatives, or all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains. Furthermore, the fact that the alternatives of a Markush grouping can be differently classified shall not, taken alone, be considered to be justification for a finding of a lack of unity of invention. The Office's position that the compounds of species (1) to (5) differ in chemical structures and requires a different search does not show lack of unity of invention in the present application. The Office must show that the compounds lack a common property and a common structural element.

Notwithstanding the impropriety of the Office's position, applicants also submit that species (1) to (5) share a significant structural element. The structure common to the species is a phosphorous atom and bicycloalkyl structure, as illustrated below:



(wherein R contains a bicycloalkyl structure). Additionally, O, S and Se belong to the same group in the periodic table and have similar chemical properties (e.g., an optically low dispersability and a high refractive index).

The Office has also failed to show lack of unity of invention regarding species (6) and (7). Species (6) is recited in claim 2, which recites a dependency on claim 1. Species (7) is recited in claim 3, which recites a dependency on claim 2. Annex B of the Administrative Instructions under the PCT provides that unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. I.e., unity of invention is presumed to exist between an independent claim and all claims dependent thereon. Consideration of unity of invention between an independent and dependent claim is in order only if an independent claim does not avoid the prior art. The Office has not properly shown lack of unity of invention regarding species (6) and (7)

since the Office has not shown how claim 1, upon which the claims reciting species (6) and (7) ultimately depend, fails to avoid the prior art.

The foregoing is believed to be a complete and proper response to the Office Action dated November 27, 2006, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,
KUBOVCIK & KUBOVCIK

Ronald J. Kubovcik
Reg. No. 25,401

The Farragut Building
Suite 710
900 17th Street, N.W.
Washington, D.C. 20006
RJK/jbf

Tel: (202) 887-9023
Fax: (202) 887-9093